

REMARKS

Claims 1-28 are pending in the instant application. At the outset, Applicant gratefully acknowledges the allowance of claims 1-7 and 28-29, as well as the indication of allowable subject matter in claims 9-10, 15, 18-20 and 24. In the Office Action, claims 18-20 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to elaborate on the nature of the recited contact (e.g., electrical or mechanical). Claim 8 is rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,688,270 to Yates, et al. (hereinafter, "Yates"). Claims 21-23 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,821,273 to Mollenauer (hereinafter, "Mollenauer"). Claims 8, 11-14, 16-17 and 25-27 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Mollenauer alone.

In response to the rejection under 35 U.S.C. § 112, second paragraph, as amended above, claim 18 recites "electrical contacts", consistent with the Examiner's interpretation. This amendment is consistent with the description of the contacts throughout the application as originally filed. No new matter has been added. Applicant respectfully submits that the rejection has been obviated, and kindly requests favorable reconsideration and withdrawal.

Turning to the merits of the claims, Applicant respectfully traverses the rejections. Regarding claim 8, the claim recites an ablation device comprising, *inter alia*, an actuation mechanism releasably coupled to the proximal end of the second jaw. The Office Action avers that this feature is taught in Yates. Applicant respectfully disagrees. There is no teaching or suggestion in Yates that the actuation mechanism is releasably coupled to either jaw. For example, Fig. 15 illustrates that the jaws are captured within enclosure tube 38, and are not shown to be releasable. Therefore, claim 8 is distinguished over Yates. See, *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.*, 730 F.2d 1452, 221

USPQ 481 (Fed. Cir., 1984) (“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”)

Turning to the rejection of claims 21-23 over Mollenauer, independent claim 21 recites a stapler head comprising, *inter alia*, a staple holder that is removably receivable by the second of two jaws. The Office Action broadly asserts that Mollenauer teaches all features of claims 21-23, but does not identify the structure as recited in the claims. Specifically, nowhere does Mollenauer teach or suggest a removably receiveable staple holder. Applicant respectfully suggests this feature of the claim may not have been given its due patentable weight. Claims 22-23 each depend from claim 21. These dependent claims are each separately patentable, but are offered as patentable for at least the same reasons as their underlying independent base claim. Favorable reconsideration and withdrawal of the rejection is kindly requested.

Applicant now refers to the rejection of claims 8, 11-14, 16-17 and 25-27 as allegedly obvious over Mollenauer alone. Applicant notes that although claim 8 is included in the statement of rejection over Mollenauer, this claim is not treated on its merits in the explanation of the reasons for rejection. Applicant presumes the inclusion of claim 8 was a mere oversight. The Office Action alleges that it would have been obvious to provide an electrode holder that is removably receiveable by one of two clamp jaws, because separating elements is a design consideration within the level or ordinary skill in the art, citing *In re Dulberg*, 283 F.2d 522, 129 USPQ 348 (CCPA 1961).


The Office Action notes that *Dulberg* relates to cases where removability is desirable. To establish prima facie obviousness, there must be some suggestion or motivation to modify the reference. See, *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). “Rarely, however, will the skill in the art component operate to supply missing knowledge or

prior art to reach an obviousness judgment.” *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). Further, the absence of such a suggestion to combine is dispositive in an obviousness determination. *See, Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). “The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence.” *Teleflex, Inc. v. Ficosa North American Corp.*, 299 F.3d 1313, 63 USPQ2d 1374 (Fed. Cir. 2002) (Citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)).

In this case, there is no evidence outside Applicant's own specification to support the Office Action position that separation of the electrode was in fact desirable. In the absence of such a suggestion or motivation to combine, the rejection cannot stand. Therefore, Applicant kindly requests favorable reconsideration and withdrawal of the rejections.

In light of the foregoing, Applicant respectfully submits that all claims recite patentable subject matter, and kindly requests an early notice of allowability. If the Examiner has any reservation in allowing the claims, and believes that a telephone interview would advance prosecution, he is kindly requested to telephone the undersigned at an earliest convenience.

Respectfully Submitted,



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